

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW L. ABRAMS and ANAND V. GUMASTE

Appeal No. 1998-0805
Application No. 08/599,508¹

ON BRIEF

Before McCANDLISH, ***Senior Administrative Patent Judge***, MEISTER
and ABRAMS, ***Administrative Patent Judges***.

ABRAMS, ***Administrative Patent Judge***.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1-20, 22 and 24-43, which at that point constituted all of the claims remaining of record in the

¹ Application for patent filed January 25, 1996.

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application. Subsequent to the final rejection, a number of the claims were amended and claims 3, 22, and 34-43 were canceled. However, the examiner maintained the final rejection, leaving claims 1, 2, 4-20 and 24-33 before us on appeal.

The appellants' invention is directed to a dry powder inhaler. The invention is illustrated by reference to claim 1, which reads as follows:

1. A dry powder inhaler comprising, a first chamber in which means for deaggregating a dry powder by vibrating said powder,² a first air flow passageway in which the deaggregated powder can be separated by size, and a second air flow passageway in which the size-separated powder can be picked up and carried for inhalation by a patient.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

² This phrase is confused. It would appear that "in which" should read --having--. In any event, correction should be made.

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| Wilke et al. (Wilke) 1976 | 3,948,264 | Apr. 6, |
| Burns et al. (Burns) 1994 | 5,284,133 | Feb. 8, |
| Calvert et al. (Calvert) 4, 1996 | 5,522,383 | Jun. |
| (filed Jun. 14, 1991) | | |
| International patent 1990 | WO 90/13327 | Nov. 15, |
| application (Hodson) | | |
| British patent application 1993 | 2 262 452 | Jun. 23, |
| (Smith) | | |

THE REJECTIONS³

Claims 1, 18 and 19 stand rejected under 35 U.S.C. §
102(b) as being anticipated by Wilke.

The following rejections stand under 35 U.S.C. § 103:

- (1) Claims 2, 4, 6 and 20 on the basis of Wilke and Smith.
- (2) Claim 5 on the basis of Wilke and either Burns or Hodson.
- (3) Claim 24 on the basis of Wilke and Calvert.
- (4) Claims 17 and 26-33 on the basis of Wilke and Hodson.

³ A rejection of claims 18, 19, 20 and 23 under 35 U.S.C. § 112, second paragraph, was withdrawn after being overcome by amendment (see Paper No. 20).

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- (5) Claims 13-16 on the basis of Wilke and Burns.⁴
- (6) Claims 7-12 on the basis of Wilke and Hodson.
- (7) Claim 25 on the basis of Wilke, Hodson and Calvert.

OPINION

Rather than reiterate the opposing viewpoints of the examiner and the appellants here, we refer to the Answer (Paper No. 15) and the Briefs (Papers Nos. 11 and 17) for the full explanations thereof.

The Rejection Under 35 U.S.C. § 102(b)

Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See ***In re Paulsen***, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and ***In re Spada***, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). It does not require that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the

⁴ This was recited in the Answer as being on the basis of Wilke, alone. However, that apparently was an error, for see Paper No. 7 (the final rejection), page 8.

reference, *i.e.*, all limitations of the claim are found in the reference. See **Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984). It is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of the claim. See **In re Mott**, 557 F.2d 266, 269, 194 USPQ 305, 307 (CCPA 1977).

Claim 1 recites a first chamber having means for deaggregating a dry powder by vibrating the powder, a first air flow passageway for separating the deaggregated powder by size, and a second air flow passageway in which this powder can be carried to the patient for inhalation. While not precisely identified in the specification by the language used in the claim, we understand that the "first air flow passageway in which the deaggregated powder can be separated by size" is a passageway through which the deaggregated powder passes "prior to the introduction into a second air flow passageway for delivery to a patient" (Brief, page 19). In the embodiment shown in the appellants' Figure 3, this would appear to include at least the unnumbered vertical passageway

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leading from powder dispensing chamber 51 to air conduit 31, in which a flow arrow is shown.

Wilke discloses an inhaler comprising a chamber (in passage 4) having means for deaggregating a dry powder in a capsule (13) by vibrating the capsule, and a flow passageway (12) for carrying the deaggregated powder to the patient for inhalation. In the Wilke device, the powder discharges from the chamber in which the capsule is positioned directly into the air flow passageway from which the patient inhales. Wilke does not disclose or teach an additional passageway in which the deaggregated powder can be separated by size and thus, from our perspective, clearly lacks one of the components required by claim 1. We do not agree with the examiner's manner of reading the language of claim 1 onto the Wilke inhaler, which appears to apply the labels of both "chamber" and "first air flow passage" to the chamber of Wilke.

It therefore is our conclusion that Wilke fails to anticipate the subject matter recited in claim 1, and we will not sustain the Section 102 rejection of claim 1 or, it follows, of claims 18 and 19, which are dependent therefrom.

The Rejections Under 35 U.S.C. § 103

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The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, ***In re Keller***, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See ***Ex parte Clapp***, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, ***Uniroyal ,Inc. V. Rudkin-Wiley Corp.***, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1052 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

Independent claim 7 stands rejected as being unpatentable over Wilke in view of Hodson. Claim 7 recites, *inter alia*, the chamber and the first and second air flow passageways that also were recited in claim 1, albeit in somewhat different

fashion, and the examiner again relies upon Wilke for disclosing these elements. Considering the teachings of Wilke in the light of Section 103 rather than Section 102(b) does not alter our conclusion that the claimed "first air flow passageway" is lacking. Hodson, which was cited by the examiner for other purposes, also fails to disclose or teach an air passageway in which powder suspended in air as a result of vibration can be separated by size.

It therefore is our view that the combined teachings of Wilke and Hodson fail to establish a *prima facie* case of obviousness with regard to claim 7. This being the case, we will not sustain the rejection of independent claim 7 or, it follows, of claims 8-12, which depend therefrom.

The rejection of independent claim 13 and dependent claims 14-16 on the basis of Wilke and Burns also will not be sustained, on the basis of the same reasoning that was set forth above regarding claims 7-12, for Burns fails to disclose or teach the claimed first air flow passageway.

Consideration of the teachings added by Smith (claims 2, 4, 6 and 20), or Calvert (claims 24 and 25), or other combinations of secondary references (claims 5, 17 and 26-33),

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also fail to cure the basic problem with Wilke, for none disclose or teach the claimed first air flow passageway. This being the case, the rejections of dependent claims 2, 4-6, 17, 20 and 24-33 also will not be sustained.

SUMMARY

None of the rejections are sustained.

The decision of the examiner is reversed.

REVERSED

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| HARRISON E. McCANDLISH |) | |
| Senior Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| JAMES M. MEISTER |) | APPEALS |
| Administrative Patent Judge |) | AND |
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